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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,759

09/15/2003

Uwe Bacher

02581-P0544A

1909

24126

7590

06/17/2009

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EXAMINER

LANG, AMY T

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

06/17/2009

PAPER

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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte UWE BACHER

Appeal 2009-001102
Application 10/662,759
Technology Center 3700

Oral Hearing Held: May 21, 2009

Before DEMETRA J. MILLS, LORA M. GREEN, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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PROCEEDINGS

MS. BEAN: Calendar No. 63. Mr. White.
JUDGE MILLS: Thank you.
MS. BEAN: You're welcome.

1 JUDGE MILLS: Good morning, Mr. White. How are you?

2 MR. WHITE: Good. How are you?

3 JUDGE MILLS: Okay.

4 MR. WHITE: Would you like me to sit or stand?

5 JUDGE MILLS: People usually stand at the podium, and you can get
6 settled.

7 MR. WHITE: Okay.

8 JUDGE MILLS: You have 20 minutes, and you can begin whenever
9 you're ready.

10 MR. WHITE: Okay.

11 JUDGE MILLS: And if you do have a business card for the court
12 reporter, it would be helpful for her --

13 MR. WHITE: Yes, I do. Thank you.

14 JUDGE MILLS: We are familiar with the record in this case and the
15 particular issues, so if you'd like to focus on anything in particular and jump
16 right in, that's fine.

17 MR. WHITE: Okay. This -- I was going to summarize a little bit, but
18 first I'll just say in this case the Examiner's obviousness determination is
19 based on an impermissibly broad interpretation of a claim term. When the
20 claims are interpreted correctly, it's clear that the references cited by the
21 Examiner do not disclose all the limitations of the claims.

22 As you know, claims 1 to 9 -- claim 1 through 9 are rejected under
23 Section 103. They're all subject to the present appeal, and claim 1 is the
24 only independent claim. Claim 1 relates to a medical instrument with a
25 handle on a proximal end of a shaft, and the handle activates a tool on the
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1 distal end. Figure 1 of the application kind of shows a broad overview of
2 the, the device. An activation rod connects the handle to the -- to a tool shaft
3 of the tool, and the tool shaft and the activation rod have protuberances
4 and/or recesses for making a form locking connection by means of a
5 movement exclusively in one direction that is essentially perpendicular the
6 longitudinal axis of the activation rod. This is the language of claim 1.

7 The Applicant believes that the invention would not have been
8 obvious. The Examiner thus far has pointed to no reference that discloses or
9 even suggests engagement of a tool shaft or an activation shaft by means of
10 a movement exclusively in one direction.

11 JUDGE FREDMAN: So in your figures it's, it's very hard for these
12 three-dimensional things to be seen again when they're only two-
13 dimensionally shown.

14 MR. WHITE: Yes.

15 JUDGE FREDMAN: I assume that like in figure 3 or 4 or whichever
16 one you want to point to there is some asymmetry that's allowing it to turn in
17 one direction and not the other? There's some element that's preventing it
18 from turning in the other direction?

19 MR. WHITE: Well, looking at -- I think a good figure, yeah, figure 3
20 or figure 2B.

21 JUDGE FREDMAN: Okay --

22 MR. WHITE: I'm a little confused when you say turn.

23 JUDGE FREDMAN: Well, how -- connect. How is it connecting
24 such that it cannot move in more than one direction?

25 MR. WHITE: So the rod 6 is the activation rod.

26

1 The tool shaft is 7.

2 JUDGE FREDMAN: Right.

3 MR. WHITE: On the end of the rod 6, there is a part of the generally
4 cylindrical rod that's chopped off of it.

5 JUDGE FREDMAN: Right.

6 MR. WHITE: That's the tangential leveling. 9A is a stud.

7 JUDGE FREDMAN: Right.

8 MR. WHITE: So actually if you look at -- and I don't mean to distract
9 your attention from those figures, but if you look at straight, for example,
10 figure 4, the stud is similar to the part of that rod designated by 12 in straight
11 figure 4. And that stud will fit between the two end parts of the tool shaft 7
12 that's designated by 9B in figure 2B of, of the Applicant's drawing.

13 JUDGE FREDMAN: Okay.

14 MR. WHITE: So now looking back at the rod 6, at the very end there
15 is a head area 8A. That has an overhanging part, a protuberance, and that
16 corresponds to a recess in the tool shaft.

17 JUDGE FREDMAN: Right.

18 MR. WHITE: So that enables the rod to come down in one direction
19 to engage the shaft, but that head area prevents it from going further. So
20 it's -- it locks into that engagement.

21 JUDGE FREDMAN: Okay, so by engaging, what you mean is that
22 it's actually just basically forming that fit connection?

23 MR. WHITE: Correct, and that fit correction is shown in figure 2A.

24 JUDGE FREDMAN: Right. Well, then thanks for your clarification.

25

26

1 MR. WHITE: And that -- the fact that only one direction is used to
2 engage the two parts of the tool is important, and this is the aspect that's not
3 shown in any of the references. The primary reference is LeMarie, and this
4 is a -- this is also a medical device with a handle, a shaft and a tool, but as
5 the Examiner acknowledges, the construction of the activation rod for
6 activating the tool with the tool shaft requires more than just movement in
7 one direction to complete its construction.

8 And for confirmation of that, the Examiner points to figure 12, and
9 you can see in figure 12 of LeMarie a similar -- I don't want to say similar
10 but the connection between the activation rod and the tool rod where the
11 two, the two rods have corresponding protuberances and recesses. However,
12 in column 9 of this patent, it's stated clearly that the link assembly 240 is
13 assembled and disassembled in a bayonet-type fashion. A cavity 244 is
14 sloped and twisted so that the actuator 248 must be rotated 90 degrees during
15 insertion and removal. Thus, movement in more than one direction is
16 required, and this, this is inconvenient, particularly for surgeons who are in
17 the middle of a surgery who want to switch their tools.

18 The Examiner then looks at Strait, which is U.S. Patent 2,334,449,
19 and says that this line shaft coupling discloses the movement in exclusively
20 one direction. However, we disagree. The Applicant disagrees. Figures 4
21 and 5 of Strait show that the one -- the end of one shaft is engaged with the
22 end of a second shaft by bringing the two shafts together either from above
23 or from below and that it can pass through. After they're brought together, a
24 collar that rides on threads on the outside of the shafts is put in a position
25 that locks the two shafts together. The, the Examiner doesn't disagree that
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1 the shafts in Strait can be brought together in two, in two ways, either from
2 above or below. The Examiner says that that is the same as movement in
3 one direction. This is where we disagree, and it's just not a reasonable
4 interpretation of the claim limitation movement in exclusively one direction
5 when read in light of the specification and the drawings. The proper
6 interpretation is one-way movement from point A to point B along a line,
7 not either back or forth movement between two points along a line. It's like
8 saying while the, the compass directions of north and south are on the same
9 line, moving north is not the same as moving south. These are two
10 directions --

11 JUDGE FREDMAN: Does your specification provide any definition
12 that supports that?

13 MR. WHITE: That supports movement in exclusively one direction?

14 JUDGE FREDMAN: Right, that defines that in a particular way.

15 MR. WHITE: It does not say -- it does not set movement exclusively
16 in one direction equals this, but I, I believe these terms are clear to one of
17 skill in the art in light of the drawings and the description associated
18 particularly with drawings 2A, 2B and 3. The Applicant doesn't understand
19 how one could, could interpret the figures to allow connection the way that
20 Strait shows it. It's just impossible with the design and the way it's claimed.

21 JUDGE MILLS: Did you have any further argument?

22 MR. WHITE: Well, I would be happy to answer any more questions,
23 and I could make comments regarding the dependent claims 5 and 8 which
24 we provided some other information on in the brief. These -- the elements
25 that are defined in these claims are clearly not obvious for reasons in
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1 addition to those I just described for claim 1. Claim 5 provides more detail
2 of the tangential leveling, the overhanging head area and the recess that
3 corresponds to these parts of the activation rod.

4 JUDGE MILLS: Could you point to the area in the specification
5 where the tangential leveling is defined or discussed? Because I think the
6 Examiner had some question as to deriving the meaning from the figures or
7 what you're relying on.

8 MR. WHITE: Yes. I -- paragraph 29 describing figures 2A to 4, the
9 recess is -- now I notice that there is a little bit of -- there is an extra 9 in the
10 drawings that I think will have to be fixed, but just bear with me for one
11 second. The recesses 9 on the activation rod 6 are formed by tangential
12 levelings which are configured on two opposite sides of the activation rod 6
13 in such a way that the activation rod in the area of this leveling consists of
14 only a narrow middle stud. And looking at figure 2B, the activation rod 6, I
15 think it's clear that the tangential leveling refers to the flattened parts that
16 form the stud. And then the head area 8A is also described in paragraph 29
17 as overhanging the middle stud in the radial direction and forms a
18 protuberance 8.

19 So the Examiner's interpretation of these elements as being disclosed
20 in Strait is simply wrong. There is no overhanging head nor could there be,
21 because Strait, Strait clearly shows in figure 405 that it can pass through and
22 be engaged in one of two directions.

23 Now the last bit I'll say is regarding claim 8 which relates to the
24 additional feature of a spring. A spring element is placed between the
25 activation rod and the tool, and the spring will provide a bias to help keep
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1 the parts together, add some friction between them. The Examiner points to
2 the use of a spring in LeMarie, particularly figure 14B, and says that from
3 what I can understand from his -- her rejection that if you take the coupling
4 of Strait, you add that to LeMarie but then you retain the spring, you'll have
5 that claim, but there would be no -- Applicant submits that there would be no
6 reason to retain that spring with the coupling of Strait given that the two rods
7 in Strait are locked together by a threaded collar. So essentially both of the
8 shafts in Strait are bearing against the threads and tightly held there so the
9 spring I don't believe would serve any purpose, nor would one of skill in the
10 art believe that it would.

11 JUDGE MILLS: The spring is which element in your figures?
12 Thirteen it looks like.

13 MR. WHITE: Yes, it's shown schematically in figure 4.

14 JUDGE MILLS: Okay.

15 MR. WHITE: And I welcome any questions, but I think that's all I'd
16 like to say at this point.

17 JUDGE MILLS: Okay. We understand your argument. I don't have
18 any further questions. No. Thank you very much for your time.

19 MR. WHITE: Great. Thank you.

20 (Whereupon, the hearing concluded at 1:50 p.m., on May 21, 2009.)
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